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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,921

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Daniel Lecomte

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EXAMINER

KIM, STEVEN S

ART UNIT

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3685

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,921	Applicant(s) LECOMTE, DANIEL	
	Examiner STEVEN KIM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/5/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the US Application No. 10/551,921, filed on October 5, 2005.

Status of Claims

2. Claims 21-40 have been examined.
3. Claims 21-40 are pending.
4. Claims 1-20 have been canceled by the Applicant.

Drawings/Specification

5. The drawings are objected to under 37 CFR 1.83(a) because they fail to show as described in the specification. The specification discloses Fig. 1 and details the components in Fig. 1. However, there is no drawing that was filed on the application. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary,

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the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 21-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Per Claim 21, the claim recites period of development, i.e. an "initial stage", "a stage selection by the user", "modification stage". The period of development is not a process, machine, manufacture or composition of matter.

9. As per claims 22-40, the claims are rejected similarly since each depends on claim 21.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 21-40 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

12. The claim(s) are replete with indefinite, functional, intended use language, non-functional descriptive material and use of terms that lack antecedent basis. For example, the independent claim 21 is directed towards a process/method, however, the Applicant recites "initial stage", "stage of selection", "modification stage" which are merely phases or period of development and do not recite **positive steps/method**. Furthermore, in regards to claim 21, the Applicant recites "standard" and "standardized". Such terms are relative terms which render the claim indefinite. The term "standard" and "standardized" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

13. Examples of terms that lack antecedent basis:

- "the material support" in claim 21,
- "the support" in claims 24 and 25,
- "the video server" in 26,
- "the physical support" and "the video stream" in claim 30
- "the synthesis device", "the equipment" and "the original stream" in claim 31,
- "the device", "the original stream" and "the equipment" in claim 34.

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14. Claim 27 recites “the stage of recording the modified main stream” is “conditioned by transmission by the user of identifying information”. The claim language is unclear to one of ordinary skill. The relationship of the elements is unclear. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed-In re Zletz,13 USPQ2d 1320 (Fed. Cir. 1989)

15. Claims 35-40 claim a system and a method, which renders the claim ambiguous. For examination purposes, the examiner will interpret (this/these) claim(s) as being directed to a method only.

16. Above are few examples of errors in the claim language used by the Applicant and do not represent comprehensive listing of errors. **Appropriate review/correction is required.**

17. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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19. Claim 35 recites "the process according to claim 21, wherein the client equipment comprises a counter of a number of possible representations". However, the subject matter, specifically **counter** and **a number of possible representations**, is not disclosed in the specification.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,892,900 to Ginter et al., hereinafter referred to as "Ginter", in view of US Patent 7,382,969 to Dawson.

22. In regards to claims 21 and 35-40, Ginter discloses a process for distributing digital video products with a restriction of at least certain rights of representation and reproduction (see col. 1, lines 16-30), comprising:

- an initial stage of forming a bank of original digital video sequences on a publicly inaccessible server for each request made by a user (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55), and

- a stage of selection by the user of one or several sequences of the video bank (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55), which selection stage activates
 - a stage for transmitting the main stream modified at a distribution site (see Fig. 1 and Fig. 3),
 - a stage for recording the modified main stream at the distribution site on a standardized support material (see col. 3; lines 22-26, delivery means including optical/magnetic disk, col. 6-21; col. 62, lines 31-50), and
 - a stage of sending complementary digital information to the user during viewing of the modified main stream sent to the user on the material support supplied by the distributor (see col. 26, lines 10-43, use of clearinghouse to control the VDE activities; col. 309, lines 1-18, routing of information using two containers; col. 342, lines 21-35, use of two depositories).

23. While Ginter discloses a modification stage of packaging elements of content into a container (see col. 59, lines 7-67), Ginter does not explicitly disclose a modification stage producing a modified main stream in a nominal format of a selected original video sequence, but whose content was modified by cutting into two parts, a larger part of which is recorded in the modified main stream that cannot be used on standard reading equipment, and a smaller part that is retained in the server within complementary digital information personalized for each user and complementary to the modified main stream.

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24. However, Dawson discloses a modification stage producing a modified main stream in a nominal format of a selected original video sequence, but whose content was modified by cutting into two parts, a larger part of which is recorded in the modified main stream that cannot be used on standard reading equipment, and a smaller part that is retained in the server within complementary digital information personalized for each user and complementary to the modified main stream (see Fig 6A, stream split into two part, marred content and extracted video).

25. Ginter and Dawson are analogous art since they are from the same field of endeavor of protecting/controlling content usage. It would have been obvious to one of ordinary skill in the art to combine the teachings. The motivation for doing so would have been to allow flexible and additional layer of protecting the content usage.

26. As per claim 22 and 23, Ginter discloses wherein the transmission stage of the modified main stream further comprises a stage of storing digital information that identifies the distributor, wherein the modified main stream contains digital information identifying the distributor (see col./line 37/15-38/35, watermarking; col. 304, lines 17-19).

27. As per claim 24. The process according to claim 21, wherein the support is a DVD disk (see col. 3, lines 18-29; col. 4, lines 14-18).

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28. As per claim 25. The process according to claim 21, further comprising a stage of reading the support with an apparatus comprising a user identifier (see col. 42, lines 35-40; col. 43, lines 10-14; col. 45, lines 57-62).

29. As per claim 26. The process according to claim 21, wherein the selection stage is realized by the user from a personal terminal of the user communicating with the video server by a public telecommunication network (see Fig. 1 and Fig 3).

30. As per claim 27. The process according to claim 21, wherein the stage of recording the modified main stream at the distribution site is conditioned by transmission by the user of identifying information (see above limitation on claim 21, user selection necessarily anticipates this limitation, col. 177, lines 49-67).

31. As per claim 28, Ginter discloses wherein the stage for modifying the original video sequence corresponds to a processing specific to the distributor designated by the user during the selection stage (see above limitation on claim 21 and claim 23).

32. As per claim 29. The process according to claim 28, wherein the server is connected to a database in which each specific processing is associated with an identifier of the distributor to which a resulting modified main stream is transmitted (see col. 8, lines 1-7; col. 9, lines 24-28; col. 12, lines 11-13; col. 63, lines 27-54).

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33. As per claim 30, Ginter discloses use of physical support, i.e. disk, in distributing content (see col. 3, lines 21-25). Dawson discloses sending of complementary digital information as viewing of the video stream progresses, which portion of complementary digital information is stored temporarily in an input memory that is a volatile memory (see col. 2, lines 42-50, reconstruction of the original video).

34. As per claim 31, Dawson discloses wherein the synthesis device receives the complementary digital information stored in a buffer and the modified main stream stored on a disk inserted in the equipment via a reading buffer, and the synthesis device uses information contained in the complementary digital information to modify the modified main stream to reconstitute a video stream identical to the original stream (see col. 2, lines 42-50, reconstruction of the original video).

35. As per claim 32, Ginter discloses wherein the stage of modifying the original video sequence corresponds to a processing specific for each user identified during the selection stage (see limitations in claim 21, user selecting necessarily anticipates this limitation).

36. As per claim 33 Ginter discloses wherein the server is connected to a database in which each specific processing is associated with a user (see col. 8, lines 1-7; col. 9, lines 24-28; col. 12, lines 11-13; col. 63, lines 27-54).

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37. As per claim 34, Dawson disclose wherein the device records on a portable storage the complementary digital information that permits recomposition of the original stream by equipment without the equipment necessarily being connected to a transmission network, and a physical support is then connected to an interface of a module for reconstitution of the original stream (see col. 2, lines 42-50, reconstruction of the original video).

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 5,745,569: discloses method and system for protecting copyright of digital properties using watermark.
- US Patent Application No. 2001/0029583: discloses method and system for video content distribution including interactive kiosk, content storage and a set-top box.
- US Patent Application No. 2002/0178280: discloses method and system of distributing content by dividing the content into objects.
- US Patent No. 6,226,618: discloses method and system for content distribution and controlling the usage using clearinghouse.

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39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./

Examiner, Art Unit 3685

October 9, 2008

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685